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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,424	03/07/2006	Wolfgang Brunner	23336-US	6332

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Roche Molecular Systems, Inc.  
Patent Law Department  
4300 Hacienda Drive  
Pleasanton, CA 94588

EXAMINER
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SASAKI, SHOGO

ART UNIT	PAPER NUMBER
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1797

NOTIFICATION DATE	DELIVERY MODE
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04/16/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rhea.nersesian@roche.com  
misty.prasad@roche.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,424	<b>Applicant(s)</b> BRUNNER, WOLFGANG	
	<b>Examiner</b> Shogo Sasaki	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 1/27/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/29/2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/2010 has been entered.

### ***Claim Interpretations***

2. Claim 1 does not positively set forth "one or more reaction vessels" and "a lid for the reaction vessel" as part of the claimed subject matter. Any further references to said elements were not given patentable weight even if those references further limit said unclaimed element.

3. Regarding claims 1, 5 and 6, recitations [claim 1] "for the non-rotatable holding of one or more reaction vessels," "for the gripping of a lid for the reaction vessel," "to take hold of the lid" and "when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact;" [claim 5] "to clamp and hold the reaction vessels;" and [claim 6] "to hold the reaction vessel" and "so that a reaction vessel inserted in the openings of the perforated plates is immobilized," which are directed to the manner in which a claimed apparatus is intended to be used do not distinguish the claimed apparatus from the prior art.

### ***Claim Objections***

4. Claim 10 is identified as original. However, a word is deleted from claim 10. The status identifier should be corrected.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the reaction vessels and the lid for the reaction vessel are not recited as part of the claimed subject matter. Applicant attempts to further define the claimed elements in relationship to how applicant intends for the respective elements to be used or function with the unclaimed reaction vessel and lid. The structure of the device is not defined or structurally limited by the intended use/function with other unclaimed elements.

It should be noted that one is not required to use the claimed device in the same manner as intended by applicant. The "for" clauses in claim 1 are generally narrative and do not further structurally limit the apparatus. Claim 1 is replete with narrative intended use phrases that do not further structurally define the claimed apparatus. (It is noted that a lid for "the reaction vessel" in line 4 should be "said/the one or more reaction vessels.")

The recitation "for the non-rotatable holding of one or more reaction vessels" is an intended use of the holding device. The recitation is not further structurally limiting. The holding device of claim 1 is not defined by any specific structural elements. Therefore, any device that is capable of holding is equivalent to the holding device in claim 1.

It is unclear what defines the "non-rotatable holding." In addition, since said element is not defined by any specific structural components, it is unclear how said element can perform the recited intended function.

The phrase "when..." in line 8 indicates conditional usage of the claimed structure. The conditional usage does not further limit the structure. Said "when" clause merely states how applicant intends for the claimed apparatus to function with unclaimed elements, if one chooses to use the device in the manner under the recited

condition. However, as previously stated intended use and conditional usage does not further structurally limit a claimed apparatus.

As to the phrase "automatic" in the preamble of claim 1, it is unclear how the device can be classified as "automatic" when no automating structural element, such as computer, processor, controller, or any other electronic component is positively claimed.

Furthermore, the structural cooperative relationships between the holding device; the gripper with passive gripping jaws; and the rotating mechanism are unclear.

Claim 1 recites the limitations, "the non-rotatable holding," "the gripping of a lid" and "the area between the gripping jaws." There are insufficient antecedent basis for this limitation in the claim.

Regarding claim 2, it is unclear where insertion slops are located on the gripping jaws.

Regarding claim 3, it is unclear where "their gripping surfaces" are located with respect to the gripping jaws on the gripper. The gripping jaws possessing gripping surfaces are not previously recited in the claims 1-3. The "direction of rotation" is not a structural element. It is unclear how other elements can be defined relative to the direction of rotation. Is the direction of the rotation defined by the rotation mechanism or the rotated gripper.

Regarding claim 4, "the cutting web" is inconsistent with "one or more cutting webs" in claim 3. Furthermore, there are multiple jaws with surfaces on the gripper. Thus it is unclear which web on which surface has the height.

Regarding claim 5, the recitation "to clamp and hold reaction vessels" is an intended use of the clamping mechanism. The recitation is not further structurally limiting. The clamping mechanism is not defined by any specific structural elements. Therefore, any device that is capable of clamping is equivalent to said element as claimed. In addition, since said element is not defined by any specific structural components, it is unclear how said element can perform the recited intended use. (It is noted that "the reaction vessel" should be "said/the one or more reaction vessels.")

Regarding claim 6, what structure is the top and the bottom plates arranged on to be stationary? Does the middle plate slide up and down or side to side with respect to

the top and the bottom plates? What structure(s) define the first and the second position for the middle plate?

Regarding claim 7, how is the middle plate capable of only sliding in a single direction with respect to the top and bottom plates of claim 6?

Regarding claim 8, it is unclear which openings on which plates have wider openings relative to other openings. What openings are arranged at right angle to the sliding direction? The "direction of sliding" is not a structural element. It is unclear how other elements can be defined relative to the direction of sliding (Claims 8-10).

Regarding claims 9 and 10, it is unclear what portion of the plates comprises the projections extending into the openings. It is also unclear if one opening on each plate comprises the plurality of projections extended into the opening; or each opening on each plate comprises a projection.

Regarding claim 9, the recitation "the section area" lacks antecedent basis. It is also unclear what is meant by or what is considered a center line of the opening.

Regarding claim 10, it is unclear what is meant by "opposite" to the projection of the middle plate.

Claim 10 is identified as original. However, a word is deleted from claim 10. The status identifier should be corrected.

Regarding claim 11, it is unclear if the means for fixing is the same means for fixing in claim 6 or some other means for fixing. It appears that the means for moving should be recited as the means for moving... between the first and the second position.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Burt et al. (US 4674340).

Regarding claims 1-5, Burt et al. disclose a device (Fig. 1-6) comprising:

- a holding device (Fig. 1: 4 and 10; and Fig. 2);
- a gripper (74), wherein the gripper has gripping jaws (82) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (64, 66, 68, 70 and 80);
- wherein the gripping jaws have insertion slopes (84);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (88);
- wherein the cutting web projects beyond the gripping surface (Fig. 4 and 5); and
- wherein the holding device has a clamping mechanism (Fig. 2).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (US 4674340) in view of Marino (US 6132684).

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Regarding claims 6-8 and 11, Burt et al. disclose all of the limitations as set forth above.

However Burt et al. do not teach the holding device specifically claimed in 6-8 and 11.

Marino discloses a holding apparatus for holding resilient plastic tubes (abstract; entire disclosure; and Fig. 1-12) comprising:

- three perforated plates (102, 104 and 106) arranged one above the other as a bottom plate (Fig. 8), a middle plate and a top plate, each of the perforated plates having a plurality of openings (Fig. 1-12), wherein the top and bottom perforated plates are arranged so as to be stationary, with the openings in the top and bottom perforated plates being flush with one another (column 4, lines 13-17; Fig. 6, 8 and 10), and the middle perforated plate is capable of sliding between a first position in which the openings in the middle perforated plate are aligned with the openings of the top and bottom perforated plates, and a second position in which the openings are arranged somewhat offset relative to the openings of the top and bottom perforated plates, so that a reaction vessel inserted in the openings of the perforated plates is immobilized (column 3, line 60-column 11, line 59);
- means for moving and fixing (Fig. 5, 7-9) the middle perforated plate in the second position;
- wherein the middle perforated plate is mounted so as to slide in a single direction of sliding (column 3, line 60-column 11, line 59); and
- wherein the openings in the direction of sliding are wider than those at right-angles to the direction of sliding (column 3, line 60-column 11, line 59).

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.



Regarding claims 9 and 10, modified Burt et al. disclose all of the limitations as set forth above.

However Burt et al. do not teach the projections provided in the holes of the plates, which extend into the interior of said holes.

Burt et al. teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections). The projections are merely provided for giving the extra traction/friction to firmly hold the tubes in place. The very idea is already taught by Burt et al.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the same idea to the vessel holding side. The claim would have been obvious because “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.”

12. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (US 4674340) in view of Marino (US 6132684), and further in view of Hansen et al. (US 2003/0038071).

Regarding claims 9 and 10, modified Burt et al. disclose all of the limitations as set forth above. However they do not explicitly show the projections provided at the holes of plates. Burt et al. teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections).

Hansen et al. disclose a holding apparatus similar to the one disclosed by Marino (See Fig. 2-5 and 14-20). The holes (142) on plates of Hansen et al. include edges 144 which are configured to engage with projections 146 on the exterior of the tubes 120 to prevent the tubes 120 from rotating within the openings 142 when, for example, a cap (not shown) is being screwed onto a top of the tube 120 ([0041]).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of modified Burt et al. to incorporate projections as taught by Hansen et al., for the purpose of giving extra traction to hold the tubes in place. The claim would have been obvious because the technique for improving a

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particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

### ***Response to Arguments***

13. Applicant's arguments filed 1/27/2010 have been fully considered.
14. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shogo Sasaki whose telephone number is (571)270-7071. The examiner can normally be reached on Mon-Thur, 10:00am-6:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

4/5/2010

/Brian R Gordon/

Primary Examiner, Art Unit 1797